



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,664	10/09/2001	Mark D. Ackerman	112024-0078	6325

21186 7590 02/08/2007
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

BADII, BEHRANG

ART UNIT	PAPER NUMBER
----------	--------------

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/973,664

Applicant(s)

ACKERMAN ET AL.

Examiner

Behrang Badii

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of claims 15-22 in the reply filed on 11/15/06 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-14 are hereby withdrawn from further consideration.

Response to Arguments

Applicant's arguments with respect to claims 15-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants limitation that generating an electronic license that includes a plurality of software command directives embedded therein for at least one of accepting and rejecting registration, by one or more external processes or products having the soft-ware commands, and wherein each command directive includes a command name associated with one of the plurality of software commands and an inclusion or exclusion identifier for the acceptance or rejection of the registration is unclear. Examiner can only guess that the above is alluding to the upgrade to a license

Art Unit: 3694

and the procedure that is inherent to license upgrades. These procedures include questioning the user as to whether he wants the upgrade or not in a series of questions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki, USPAP 2001/0013099, and further in view of Ross et al., USP 5,553,143.

As per claims 15 and 22, Haruki discloses a method for licensing external processes on a server comprising the steps of (Abstract): Generating an electronic license that includes a plurality of software command directives embedded therein for at least one of accepting or rejecting registration, by one or more external processes, of software commands (Abstract, lines 1-9); and registering software commands based upon the software command directives (page 5 claim3); and executing the registered commands (figure 11).

Haruki does not disclose software commands or a string identifying a command name and an inclusion or exclusion identifier. Ross et al. discloses software commands and a string identifying a command name and an inclusion or exclusion identifier (the procedure of accepting or declining the upgrade to a

Art Unit: 3694

license) (col.4, 24-30; col.5, 4-15, 35-45; col.6, 33-67; col.9, 44-57; col.11, 47-55; col.12, 1-45; col.13, 40-65; fig's 5-9). It would have been obvious to modify Haruki to include software commands and a string identifying a command name and an inclusion or exclusion identifier in the license (the process of upgrading a license) such as that taught by Ross et al. in order to have portions of an encrypted license document to become available upon the registration and acceptance of the license upgrade.

Claim 16, 17, 18, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki and Ross et al. as applied to claim 15 above, and further in view of Misra et al. U.S. Patent 6,189,146.

As per claim 16, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license. Misra et al. discloses directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license (col. 7, table 1). It would have been obvious to modify Haruki to include directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license such as that taught by Misra et al. in order to better handle the management of the different part of the license agreement.

As per claim 17, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses. Misra et al. discloses the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses (col. 18, lines 17-38). It would have been obvious to modify Haruki to include the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

As per claim 18, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses. Misra et al. discloses the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses (col. 18,

Art Unit: 3694

lines 17-38). It would have been obvious to modify Haruki to include the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

As per claim 19, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses. Misra et al. discloses the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses (col. 18, lines 17-38; col. 12, lines 56-67). It would have been obvious to modify Haruki to include the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

As per claim 20, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose

Art Unit: 3694

either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user. Misra et al. discloses either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user (col. 2, lines 22-47). It would have been obvious to modify Haruki to include either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user such as that taught by Misra et al. in order to have more choices as to the installment of the electronic license.

As per claim 21, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose installing the electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server. Misra et al. discloses installing the electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally

Art Unit: 3694

signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server (col. 2, lines 22-47 and abstract). It would have been obvious to modify Haruki to include a installing the electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server such as that taught by Misra et al. in order to have a more efficient way of installing the electronic license.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
or faxed to (571)273-8300

Hand delivered responses should be brought to

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Behrang Badii
Patent Examiner
Art Unit 3694

BB


ELLA COLBERT
PRIMARY EXAMINER